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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10,049,505	05/20/2002	Didier Joisson	5639	7625

7590

03/19/2003

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EXAMINER

HALPERN, MARK

ART UNIT

PAPER NUMBER

1731

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DATE MAILED: 03/19/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/049,505

Applicant(s)

JOISSON ET AL.

Examiner

Mark Halpern

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☐ Claim(s) 16-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 16,22,26-28,30 is/are rejected.
- 7) ☐ Claim(s) 17-21,23,24 and 29 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-52)
- 6) ☐ Other

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### DETAILED ACTION

1) Acknowledgement is made of preliminary Amendment received 8/22/2002, Paper No. 7. Applicants cancel claims 1-15, and offer new claims 16-30, for consideration.

#### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2) Claims 16, 22, 25-28, 30, are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Palmer (6,406,594).

Claims 16, 22: Palmer discloses a process of making a paper product wherein cellulosic fibers in a water slurry are combined in a tank (col. 9, line 10 to col. 10, line 49) with Group I metal silicates, such as sodium silicate (col. 10, line 50 to col. 11, line 29), and further with a filler material, such as calcium hydroxide (col. 12, lines 39-68). The mixture is stirred (col. 13, line 47), and the reaction takes place about the cellulose (col. 4, lines 65-68). Palmer is silent on the formation of silicate of the mineral filler, however, it is inherent or in the least would have been obvious, to one skilled in the art at the time the invention was made, that the formation of silicate of the mineral filler occurs since the chemical ingredients and process conditions of the Palmer reaction are the same as in the present invention.

Claim 25: the addition of carbon dioxide to the process for the purpose of pH control is disclosed (col. 13, line 48 to col. 14, line 3).

Claim 26: chemical or mechanical pulp is disclosed (col. 10, lines 40-49).

Claim 27: Palmer discloses a process of making a paper product from a chemical or mechanical pulp (col. 10, lines 40-49). The paper is made by wet method from a headbox onto a moving wire. In the process cellulosic fibers in a water slurry are combined in a tank (col. 9, line 10 to col. 10, line 49) with Group I metal silicates, such as sodium silicate (col. 10, line 50 to col. 11, line 29), and further with a filler material, such as calcium hydroxide (col. 12, lines 39-68). Calcium and magnesium ions are

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provided (col. 27, lines 1-6). The mixture is stirred (col. 13, line 47), and the reaction takes place about the cellulose (col. 4, lines 65-68). Palmer is silent on the formation of silicate of the mineral filler, however, it is inherent or in the least would have been obvious, to one skilled in the art at the time the invention was made, that the formation of silicate of the mineral filler occurs since the chemical ingredients and process conditions of the Palmer reaction are the same as in the present invention. The formed paper product is dried in dryer 42. The drained water is re-circulated (col. 9, line 5 to col. 10, line 14, and Figure 11).

Claim 28: the addition of carbon dioxide to the process for the purpose of pH control is disclosed (col. 13, line 48 to col. 14, line 3).

Claim 30: chemical or mechanical pulp is disclosed. The pulp is also based on recycled paper materials (col. 10, lines 40-49).

### ***Allowable Subject Matter***

3) Claims 17-21, 23-24, 29, are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter:

The primary reason for indicating allowable subject matter is that the cited prior art does not show: a method for affixing mineral fillers on cellulose fibers in an aqueous suspension; wherein the aqueous suspension includes sodium hydrogen carbonates

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(claims 17-21); or wherein calcium hydroxide is added as milk (claims 23-24); or a manufacturing process for making sheets of paper wherein a manufacturing composition includes sodium and hydrogen carbonate ions in ionic equilibrium (claim 29).

**Conclusion**

4) Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark Halpern whose telephone number is 703-305-4522. The examiner can normally be reached on Mon-Fri, (9:00-5:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven Griffin can be reached on 703-308-1164. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-7718 for regular communications and 703-305-3599 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0651.



Mark Halpern  
Patent Examiner  
Art Unit 1731

March 17, 2003